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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TERRY PULLARO

Appeal 2008-4688
Application 10/810,347
Technology Center 3700

Decided: November 26, 2008

Before DONALD E. ADAMS, LORA M. GREEN, and
RICHARD M. LEBOVITZ, *Administrative Patent Judges*.

ADAMS, *Administrative Patent Judge*.

DECISION ON APPEAL

This appeal under 35 U.S.C. § 134 involves claims 1 and 4-14, the only claims pending in this application. We have jurisdiction under 35 U.S.C. § 6(b).

STATEMENT OF THE CASE

The claims are directed to a sport-specific training and conditioning device. Claims 1 and 4 are illustrative:

1. A sport-specific training and conditioning device for a sport using a hand-held implement having a grip portion, the device comprising a handle shaped like the grip portion of the implement, the handle having first and second ends, the device further comprising a single uniformly shaped weight that is internally fastened with the second end of the handle while the first end of the handle remains weight free such that the internal fastening of the uniformly shaped weight with the second end fastens the uniformly shaped weight to a normally non-rotatable position and such that a center of mass of the device is positioned within the uniformly shaped weight and the center of mass is less than about thirteen inches from the first end of the handle, the handle having a circumference sized between about ten and about thirty percent larger than the grip portion of the hand-held implement and the handle having a length that is longer than the uniformly shaped weight wherein the positioning of the uniformly shaped weight, the sizing of the circumference of the handle and the positioning of the center of mass are configured to direct the effect of the uniformly shaped weight in a concentrated manner to the forearms of the user during exercise with the device.

4. The sport-specific training and conditioning device according to claim 1 wherein the uniformly shaped weight has a diameter of less than about 4 inches.

The Examiner relies on the following prior art references to show unpatentability:

Smith	Des. 241,958	Oct. 19, 1976
Spivey	US 4,272,077	Jun. 9, 1981
Piccini	US 4,378,113	Mar. 29, 1983
Huffman	US 5,215,307	Jun. 1, 1993
Hart	US 6,379,261 B1	Apr. 30, 2002

The rejections as presented by the Examiner are as follows:

1. Claims 1 and 6-14 stand rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Smith, Huffman, Piccini, and Spivey.
2. Claims 4 and 5 stand rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Smith, Huffman, Piccini, Spivey, and Hart.

We reverse.

ISSUE

Would a person of ordinary skill in the art have had a reason to select various elements taught by Smith, Huffman, Piccini, and Spivey; and combine these elements in the manner set forth in Appellant's claimed invention?

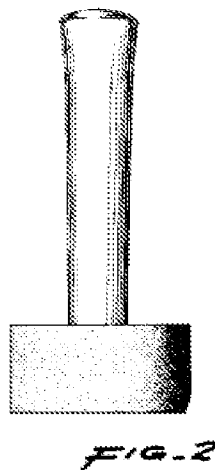
FINDINGS OF FACT (FF)

1. Claim 1 is drawn to a sport-specific training and conditioning device for a sport using a hand-held implement having a grip portion. According to Appellant's Specification the "device of the present invention is adaptable to virtually any sport that uses a hand-held implement, including baseball, golf, tennis, squash, badminton, hockey, lacrosse, et cetera" (Spec. 1). The device of claim 1 comprises (i) a handle, having first and second ends, that is shaped like the grip portion of the implement and (ii) a single uniformly shaped weight that is internally fastened with the second end of the handle. Claim 1 requires that the first end of the handle remains weight free. Claim 1 requires that the uniformly shaped weight is fastened to the second end of the handle in a "normally" non-rotatable position (Claim 1). Claim 1 requires that the device's center of mass is (i) positioned within the

uniformly shaped weight and (ii) is less than about thirteen inches from the first end of the handle. In addition, claim 1 requires the handle of the device to have (i) a circumference sized between about ten and about thirty percent larger than the grip portion of the hand-held implement and (ii) a length that is longer than the uniformly shaped weight. Lastly, claim 1 requires that the positioning of the uniformly shaped weight, the sizing of the circumference of the handle and the positioning of the center of mass are configured to direct the effect of the uniformly shaped weight in a concentrated manner to the forearms of the user during exercise with the device.

2. Claim 4 depends from and further limits the device of claim 1 to require that the uniformly shaped weight has a diameter of less than about 4 inches.

3. Smith is drawn to “[t]he ornamental design for a golf swing practice club, as shown and described” (Smith, col. 1, ll. 11-12). For clarity, we reproduce Smith’s figure 2 below:



“FIG. 2 is an elevation of one side of the [golf swing practice club] . . . , the other side being substantially the same but with reversed symmetry” (Smith, col. 1, ll. 3-5).

4. The Examiner finds that Smith “does not disclose the length of the device, the size of the handle, or how the weight is attached to the handle” (Ans. 3).

5. Huffman teaches that “[i]n golf, weighted golf clubs have been used but the additional weight on the end of the golf club shaft adversely affects the balance of the golfer. The weight tends to pull the golfer toward the weight” (Huffman, col. 1, ll. 7-11). Huffman discloses that

[w]hat is needed is a weighted exercise device that will allow the user to practice the specific swing of a given sport such as golf, tennis or baseball but not affect the balance of the user while performing the exercise. The weights used should be sufficient to strengthen the specific muscles required for the specific sport in question.

(Huffman, col. 1, ll. 18-24.) Huffman’s “invention provides a counter balanced shaft having a grip for the specific desired sport and the opposite ends of the shaft carry counter balanced weights” (Huffman, col. 1, ll. 26-28). Huffman teaches that “[t]he amount of weight on each end may be varied but one of the weights is always between the user’s hands and body while swinging the training device thereby allowing the user to maintain normal balance throughout the swing of the training device” (Huffman, Abstract). In addition, Huffman teaches that, for example, “[i]n golf, a conventional golf grip may be provided between the weights on the shaft or a training grip which specifically positions the golfer’s hands in a correct position may be used” (Huffman, col. 1, ll. 29-33). Huffman also teaches that “[t]he effective length of the exercise device is substantially less than the conventional golf club and is also less than a tennis racket or a baseball bat. This length will ordinarily vary between 15 and 30 inches. The

individual weights will vary between approximately two and six pounds” (Huffman, col. 1, ll. 46-51).

6. Piccini teaches a “method for warming-up an athlete’s wrist” (Piccini, Abstract). Piccini teaches that “[t]he club-like implement useful for practicing the method of the invention is approximately equal in length to an athlete’s forearm” and that “[t]he overall length of the club, in the preferred embodiment, is approximately fourteen inches” (Piccini, col. 2, ll. 18-20 and 63-65). In addition, Piccini teaches that the handle of the device “is proportioned so that its length is only slightly greater than the width of an athlete’s hand measured across the palm and perpendicular to the fingers. Thus, when the athlete desires to practice the method, one of his or her hands must overlies the other hand” (Piccini, col. 3, ll. 4-9). Piccini teaches that

This overlying relationship of the hands to each other allows the method . . . to be practiced comfortably. Further, providing an abbreviated handle portion . . . suggests to the athlete that he is not to grip the device by employing the same grip that he would on a bat or club in an actual game-situation. The purpose of the device, unlike earlier devices, is to allow the athlete to warm-up his wrists without restricting himself to the movements employed in actual game-situations.

(Piccini, col. 3, ll. 28-37.)

7. Spivey teaches “[a] golf putter which improves putting by minimizing putter jerks or yipes by preventing the non-dominant hand from overriding the dominant hand” (Spivey, Abstract). Spivey’s grip has “a circumference substantially larger than that of the shaft diameter and having a diameter from 1 to 2 centimeters less than the distance between the tip of the index

finger to the first bony prominence of the thumb joint, of the non-dominant hand” (*id.*).

PRINCIPLES OF LAW

In proceedings before the Patent and Trademark Office, the Examiner bears the burden of establishing a prima facie case of obviousness based upon the prior art. An analysis under 35 U.S.C. § 103 “need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007). However, in emphasizing this flexible approach to the obviousness analysis the Court also reaffirmed the principle that claims would likely be unobvious when “when the prior art teaches away” from their practice. *Id.* at 1740.

Further, as set forth in *In re Kotzab*, 217 F.3d 1365, 1369-70 (Fed. Cir. 2000):

A critical step in analyzing the patentability of claims pursuant to section 103(a) is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one “to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher.”

Most if not all inventions arise from a combination of old elements. Thus, every element of a claimed invention may often be found in the prior art. However, identification in the prior art of each individual part claimed is insufficient to defeat

patentability of the whole claimed invention. Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant. [Citations omitted].

In other words, “there still must be evidence that ‘a skilled artisan, . . . with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.’”

Ecolochem, Inc. v. Southern California Edison Co., 227 F.3d 1361, 1375 (Fed. Cir. 2000).

ANALYSIS

The Examiner relies on Smith to teach “a weight exercise device comprising a handle shaped like a grip portion of a sport implement having a first and second ends and a weight positioned at the second end of the handle” (Ans. 3; FF 3). The Examiner finds that Smith fails to teach “the length of the device, the size of the handle, or how the weight is attached to the handle” (Ans. 3; FF 4). The Examiner relies on Piccini to teach a device of approximately fourteen inches that comprises a handle and a weighted end (Ans. 4; FF 6). According to the Examiner, it would have been prima facie obvious to a person of ordinary skill in the art to produce Smith’s device in a size of approximately fourteen inches in view of the teachings of Piccini “in order to condition the forearms” (Ans. 4). Stated differently, the Examiner is of the opinion that the combination of Smith and Piccini teach a device as illustrated in Figure 2 of Smith that is approximately fourteen inches in length.

The Examiner relies on Spivey to teach a handle for a golf club in which the handle is about 30% larger than a standard golf grip (*id.*). Accordingly to the Examiner it would have been prima facie obvious to a person of ordinary skill in this art “to increase the size of the grip [taught by the combination of Smith and Piccini] in order to improve jerks or yipes, or in other words, improve the gripping of the implement” (*id.*). The Examiner, however, fails to account for the specific handle configuration taught by Piccini (FF 6). Piccini’s handle is configured to suggest “to the athlete that he is not to grip the device by employing the same grip that he would on a bat or club in an actual game-situation” (*id.*; App. Br. 10). Instead, Piccini requires a handle with a configuration that results in an “overlying relationship of the hands to each other [to allow Piccini’s] . . . method . . . to be practiced comfortably” (*id.*). Ignoring the foregoing, the Examiner reasons that since Huffman teaches that the grips on a counter balanced device may use grips of a particular sport implement (e.g., Spivey’s grip), then Huffman’s or Spivey’s grips must be equally applicable on the fourteen inch device taught by the combination of Smith and Piccini (Ans. 4).¹

This simply isn’t true (FF 6; App. Br. 11). Huffman’s device is not similar to the device taught by either of Smith or Piccini (*Cf.* FF 3, 5 and 6) since Huffman’s device uses weights at both ends. Thus, while we might

¹ In addition, we agree with Appellant’s contention that Huffman “teaches away from the Smith reference . . . [t]he problem that the Huffman reference allegedly solves is . . . [w]hat is needed is a weighted exercise device that will allow the user to practice the specific swing of a given sport such as golf . . . but not affect the balance of the user while performing the exercise” (App. Br. 8; FF 5).

agree with the Examiner that a person of ordinary skill may have considered using Spivey's grip on Huffman's device, a person of ordinary skill in the art would not modify Piccini's teaching with a grip that would be used in an actual game-situation. To do so, would be counter to the express teachings of Piccini (FF 6).

CONCLUSION OF LAW

A person of ordinary skill in the art would have no reason to select the various elements taught by Smith, Huffman, Piccini, and Spivey and combine these elements the manner set forth in Appellant's claimed invention.

The rejection of claims 1 and 6-14 under 35 U.S.C. § 103(a) as unpatentable over the combination of Smith, Huffman, Piccini, and Spivey is reversed.

ISSUE

Would a person of ordinary skill in the art have a reason to select the various elements taught by Smith, Huffman, Piccini, Spivey, and Hart and combine these elements in the manner set forth in Appellant's claimed invention?

FINDINGS OF FACT

8. The Examiner relies on Hart to teach "a swing trainer having a handle and weight wherein the weight has a length of 1.5 to 4 inches and a diameter of 1.25 in" (Ans. 5).

PRINCIPLES OF LAW

“In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a *prima facie* case of obviousness. Only if that burden is met, does the burden of coming forward with evidence or argument shift to the applicant.” *In re Rijckaert*, 9 F.3d 1531, 1532 (Fed. Cir. 1993) (citation omitted).

ANALYSIS

According to the Examiner,

[o]ne having ordinary skill in the art would have found it obvious to have the weight of the prior art, applied to claim 1, to be less than 4 inches in length and diameter, as taught by Hart, in order to give the device and adequate size to be used indoors or outdoors.

(Ans. 5.) The Examiner’s reliance on Hart (FF 8) fails to make up for the deficiencies in the combination of Smith Huffman, Piccini, and Spivey as discussed above. We recognize the Examiner’s assertion that “appellant makes no argument with respect to the Hart reference applied to claims 4 and 5” (Ans. 9). We note, however, that “the examiner bears the initial burden of presenting a *prima facie* case of obviousness. Only if that burden is met, does the burden of coming forward with evidence or argument shift to the applicant.” *In re Rijckaert*, 9 F.3d at 1532.

CONCLUSION OF LAW

A person of ordinary skill in the art would have no reason to select the various elements taught by Smith, Huffman, Piccini, Spivey, and Hart and

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combine these elements the manner set forth in Appellant's claimed invention.

The rejection of claims 4 and 5 under 35 U.S.C. § 103(a) as unpatentable over the combination of Smith, Huffman, Piccini, Spivey, and Hart is reversed.

REVERSED

cde

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